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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/266,935**

Applicant(s)  
**Li et al.**

Examiner  
**Jezia Riley**

Group Art Unit  
**1655**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-29 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The art unit for this application has changed. Applicant is informed, that any future response should be directed to Art Unit 1655.

*Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 1-29 are rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

Claim 1-29 are vague and indefinite because it is unclear, of what are the metes and bonds of the terms "derivatives thereof". Further it is unclear how the integer a-f, for example can be more than 1, if for example R3 is =O, or H. Also if R1, R2, and R3 are =O the N can have 6 bonds. Further, the N atom in the formula should positively charged. Additionally, the formula shows bonds crossing the brackets., but it is unclear where they should be bonded in the actual formula inside the brackets.

Claims 22-26 are vague and indefinite because it is unclear of what are the conditions fro the hybridization. Are they high or low stringency? Further what are the metes and bonds of the terms sufficient and portion.

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**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 20-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mullis et al. (4,800,159).

Mullis et al. disclose a method for amplifying any target nucleic acid and a kit. (See abstract and col. 2-5, for example).

6. Claims 20-26 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lee (Patent # 5,187,085).

Lee discloses the basic steps of the chain-termination approach to DNA sequencing where the fluorescently labeled chain-terminating nucleotides can be 2',3', dideoxy-7-deazainosine triphosphate (Col. 3-5).

7. Claims 1-8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Solomon (Organic chemistry, fifth edition, 1992, page 1094).

Solomon discloses proline on page which is viewed as the compound claimed in instant claim 1.

8. No claim is allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jezia Riley whose telephone number is (703) 305-6855. The Examiner may normally be reached Monday through Friday, 0900 - 1700 EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Gary Jones, may be reached at (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix Receptionist whose telephone number is (703) 308-0196.

Any necessary fax can be sent to (703) 308-4242.

jr

Wednesday, 29 September 1999

*Jezia Riley*  
**JEZIA RILEY**  
**PATENT EXAMINER**